

## **REMARKS**

The status of all claims is indicated above. Applicants note with appreciation the indication that Claims 6, 13, 18, 27-28, 33, 35, 37, 40, 47 and 58 would be allowable if rewritten to incorporate the limitations of the base claims and intervening claims from which they depend. Applicants wish to point out, however, that Claim 47 should have been allowed rather than indicated to be allowable because Claim 47 is an independent claim. Claims 6, 18, 27-28, 33, 35, 37, 40 and 58 are amended solely to incorporate the limitations of their respective base claims and intervening claims from which they formerly depended. Claims 6, 18, 27-28, 33, 35, 37, 40, 47 and 58 are now in condition for allowance. Applicants respectfully traverse the rejections made on the basis of prior art as set forth below.

### **Claim Rejections – 35 U.S.C. § 102**

Claims 23-26, 29-30 and 36 are rejected as being anticipated by Dock U.S. Pat. No. 3,625,228 ("Dock"). Claims 24-26, 29-30 and 36 all depend directly from Claim 23, which recites, "a first filter segment connected to the tobacco rod" and "a cavity extending into the first filter segment."

The capsules disclosed in Dock are not provided in a cavity extending into the first filter segment which includes space for capsules and excess space for receipt of capsule contents. The Office Action mischaracterizes the "absorbent, expansible material" **15** of Dock as a cavity. See Office Action at page 2. The absorbent expansible material of Dock in which capsules are embedded does not constitute a cavity as defined in the subject application. This mischaracterization of element **15** in Dock as a cavity is further evidenced by the Office Action's assertion that frusto-conical element **16** in Dock constitutes the "longitudinally extending central portion" recited in Claim 24. Claim 24 recites that this "central portion" defines the claimed "cavity." It is clear from Dock that the buffer member **16** does not define the absorbent expansible material **15**, *i.e.*, does not define a preformed "cavity" in which capsules may be inserted without occupying all of the space.

Still further distinctions are evident between the rejected claims and Dock. For example, with respect to Claim 24, Dock does not disclose "a longitudinally extending

outer portion of filter material positioned annularly around the central portion” and a “cavity” defined by the central portion. In another example, Claims 23, 30 and 36 recite size specifications for the cavity and the capsule, both of which are absent from Dock. In view of the foregoing differences between Dock and Claims 23-26, 29-30 and 36, Dock does not anticipate any of these claims. Reconsideration and withdrawal of the rejections is respectfully requested.

### **Claim Rejections – 35 U.S.C. § 103**

Claims 1, 3-5, 7-10, 15-17, 21-22, 41, 44-45, 48-57 and 59-60 are rejected as being obvious over Berger U.S. Pat. No. 3,994,306 (“Berger ‘306”) in view of Berger et al. U.S. Pat. No. 3,599,646 (“Berger ‘646”) and Dock. Applicants have amended Claims 1, 41, 48, 49 and 58, and traverse these rejections for the following reasons.

Claims 1, 3-5, 7-10, 15-17, 21-22, 51-53 and 60 recite, *inter alia*, a filter element incorporating “a cavity” defined by an inner element of filter material where the cavity includes “a first region for receipt of the . . . capsule and a second region for receipt of capsule contents.” Claims 41 and 44-45 recite, *inter alia*, “an inner element defining a cavity” where the cavity includes “a first region for receipt of the capsule and a second region for receipt of capsule contents.” Claim 48 recites, *inter alia*, a filter element having “excess air space” in a cavity which is unoccupied by the breakable capsule. Claims 54-57 recite, *inter alia*, a filter element comprised of a “cavity defined by the inner element of filter material” and “excess air space in said cavity.”

Each of the foregoing claims requires either a second region in the cavity for receipt of capsule contents or excess, unoccupied, space in the cavity for the same purpose. The claimed cavity includes sufficient space to receive capsules during manufacture and space to receive capsule contents after breakage. None of the references relied upon teaches a cavity that is purposefully designed to, not only receive during manufacture and hold one or more capsules, but also provide excess space for release of the capsule contents. In fact, in Dock, the capsules are embedded in material as opposed to being provided in an open space adapted to receive the capsule contents. Because none of the references relied upon for the rejection of Claims 1, 3-5, 7-10, 15-17, 21-22, 41, 44-45, 48, 51-57 and 60, taken individually or in combination, disclose a cavity with a first region for receipt of a capsule and a second

region for receipt of capsule contents, and/or excess, unoccupied, space in the cavity, reconsideration and withdrawal of the rejection of these claims is respectfully requested.

As amended, Claims 49-50 recite, *inter alia*, a generally conically shaped cavity including a crimped end surrounded by filter material in combination with at least one capsule disposed in the cavity. Claim 59 recites a partially crimped inner filter element which is generally conically shaped. By surrounding the crimped end with filter material, the cavity is adapted to attain a functional shape for smoking after being compressed to break the capsule(s) contained therein. The references relied upon do not teach the combination of all the elements recited in these claims. Accordingly, reconsideration and withdrawal of the rejections of Claims 49-50 and 59 is requested.

Applicants also note that Claims 9, 16, 45 and 49-53 recite size specifications for the cavity and the capsule which are not disclosed in any of the references relied upon. The Office Action states that the capsules in Dock appear to be the claimed sizes, but there is no support in Dock that the capsules shown therein (which are not breakable capsules) are in fact the claimed sizes. Accordingly, these claims differ from the prior art relied upon and withdrawal of the rejection of these claims is requested.

Claims 41, 44-45, 48 and 51 are also patentable because they recite that the filter element is adapted "to attain a shape functional for smoking after rupture of said capsule" or "to attain a functional shape for smoking after being compressed to break said capsule" or "to expand to a functional shape for smoking after being compressed to break said capsule." Berger '306, the reference relied upon to teach this element of the claims, does not disclose a filter element adapted to be compressed to break capsules and thereafter expand for smoking. Berger '306 teaches that cavities in the filter element may be filled with smoke-modifying material that does not need to be compressed, such as activated carbon. See Berger '306 column 4, lines 14-18. Likewise, Berger '646 and Dock do not disclose a filter element adapted to be compressed to break a capsule and then expanded for smoking. Accordingly, Claims 41, 44-45, 48 and 51 distinguish over the prior art for these additional reasons.

### **Conclusion**

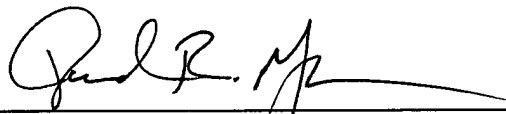
In view of the foregoing, Applicants respectfully request that the rejections of Claims 1, 3-5, 7-10, 15-17, 21-26, 29-30, 36, 41, 44-45, 48-57 and 59-60 be withdrawn

and the present application be allowed with all pending claims. Should the Office believe anything further is required to place the application in condition for allowance, the Examiner is invited to contact Applicants' representative at the telephone number listed below.

The Director is authorized to charge Deposit Account No. 03-2469 the fee required under 37 C.F.R. § 1.17(a)(1) a two month extension of time. If an additional fee is required, the Director is authorized to charge any deficiency or credit any overpayment to this deposit account. Moreover, if the deposit account contains insufficient funds, the Director is hereby invited to contact Applicants' undersigned representative to arrange payment.

Respectfully submitted,

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